

REMARKS

In accordance with the foregoing, Claims 1-11 have been amended. Claim 12 has been added. No new matter is being presented, and approval and entry are respectfully requested. Claims 1-12 are pending and under consideration. Reconsideration is respectfully requested.

In order to clarify Applicant's invention, Claims 1, and 7-11 are amended to recite features related to sending a questionnaire to participants and deciding a design of a product including the adopted options specified based on the answers to the questionnaire. The features find non-limiting support in the disclosure as originally filed. For example, the submission of the questionnaire is disclosed at page 5, lines 13-18, and producing the product according to the design that is a sum of the adopted options is described from page 15 line 25 to page 16, line 3. In order to vary the scope of protection recited in the claims, new Claim 12 has been added. New Claim 12 has non-limiting support in the disclosure and claims as originally filed.

Briefly, Applicant's invention, as recited in Claim 1, relates to "a profit sharing method used for designing a product" in which participants are provided with "a questionnaire including a plurality of questions, each question concerning an element of the product asking each participant to select one option from a plurality of options" in each question. The participants' answers including a selected option from the options available for each question are retrieved, and "one adopted option from the plurality of options of each question of the questionnaire corresponding to the element" is selected "based on the retrieved" answers. "A final design of the product in which each element is as specified in the corresponding one adopted option" is then determined. "Predetermined points [are assigned] to each participant for each question if the participant selected the corresponding one adopted option from the plurality of options of the question" and "an individual return value which should be given to the participant in accordance with the predetermined points assigned to the participant" is determined.

REJECTION UNDER 35 U.S.C. § 101

In response to the rejection of Claim 9 under 35 U.S.C. § 101 as being directed to a non-statutory subject matter, Claim 9 has been amended to recite a computer readable media storing executable codes of the profit sharing method. In view of the amended language, withdrawal of the rejection is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102(e)

In response to the rejection of Claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,571,216 to Garg et al. (hereinafter "Garg"), Applicant respectfully requests reconsideration of this rejection and traverses the rejection as discussed below.

Garg discloses a method that allows a plurality of reward scheme owners to give differential rewards, through a plurality of reward distribution agents, to various users based on the user profile. In particular, the outstanding Office Action indicates a description of an on-line gambling (or lottery) system¹ as being pertinent to teaching or suggesting the elements of the claimed invention. Applicant strongly disagrees that lottery methodology teaches or discloses the method of Claim 1. In a lottery system, the winning combination is not based on the answers provided by the participants, but instead, after players (i.e., participants) provide combinations of numbers, the lottery manager announces the winning combination. The winning combination must be independent of the players' combinations in any honest lottery system. In contrast, in the profit sharing method used for designing a product of Claim 1, the adopted options are specified based on the answers of the participants and the final design incorporates all the adopted options. In contrast, the lottery system does not disclosed "specifying one adopted option from the plurality of options of each question of the questionnaire corresponding to the element, based on the retrieved pieces of answer information" and "determining a final design of the product in which each element is as specified in the corresponding one adopted option." Therefore, Garg fails to teach or suggest every feature recited in Claim 1, so that Claim 1 patentably distinguished over the cited prior art.

In paragraphs 6 through 15 from pages 3 to 9 of the outstanding Office Action, Claims 1, 3, and 5 through 11 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,694,355 to Bahar (hereinafter "Bahar"). In light of the amendments to the claims, Applicant respectfully submits that the rejection is moot as discussed below.

Bahar discloses a method for generating new or modified designs of products over a communications network, such as the Internet. In Bahar, participants may remotely access and run a computer design program to select and manipulate product parts for designated products, in order to create a new design for the products. Additionally, an award incentive may be provided to winning designs. However, Bahar does not teach or suggest the feature recited in Claim 1 "determining a final design of the product in which each element is as specified in the corresponding one adopted option." In Bahar, the final design is a selected winner design that was submitted by a participant. The process of deciding the final design is fundamentally different in Bahar than in the present application. As none of the cited prior art, individually or in combination, disclose or suggest all the elements of independent Claim 1, Applicant submits that Claim 1, and all claims depending therefrom, are not anticipated by the asserted prior art for at least the reasons stated above.²

¹ See Column 8 lines 65-67, and Column 9 lines 1-3 and 11-19.

² MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim

Independent Claim 7 recites "determining a final design of the product in which each element is as specified in the corresponding one adopted option." Claim 7 patentably distinguishes over the applied prior art.

Independent Claim 8 and 10 recite "a module making the server computer [...] to determine a final design of the commercial article according to the adopted option for each element." Claims 8 and 10 patentably distinguish over the applied prior art.

Independent Claim 9 recites "a third executable code making the server computer [...] to determine a final design of the commercial article according to the adopted option for each element." Claim 9 patentably distinguishes over the applied prior art.

Independent Claim 11 recites "developing a design of the commercial article based on the adopted option specified for each element." Claim 11 patentably distinguishes over the applied prior art.

REJECTIONS UNDER 35 U.S.C. § 103(a)

In paragraph 17 on Page 10 of the outstanding Office Action, Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bahar in view of "MM, MM ... Blue! Public obviously was ready for a change in M&M colors" of Marli Murphy in Kansas City Star, Dayton Daily News, Dayton Ohio, Aug. 19, 1995, page 3C (hereinafter "Murphy"). Murphy reports on a public polling related to color of M&M candy. However, Murphy does not cure the above identified defect of Bahar by not teaching "determining a final design of the product in which each element is as specified in the corresponding one adopted option." Murphy does not link the public polling result with a new product (i.e., design of a product), whether the new product would include only blue M&M or blue M&M's would be included in the M&M packages in a certain proportion. On the other hand, the indicated suggestion to combine indicated in Bahar states rather general marketing principles, that is "Being informed of the going consumer trends/styles of the times, the manufacturer would be able to design the product so as to maximize its potential sale." Only in hindsight one would consider combining Bahar and Murphy based on the marketing general principles and hindsight reconstruction³ is improper. Therefore, the Applicant respectfully requests withdrawal of the §103 rejection.

In paragraph 18 on Page 10 of the outstanding Office Action, Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bahar in view of "The Sophisticated Investor" by Burton Crane (hereinafter "Crane"). In the paragraph indicated in Crane, the term

must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

³ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

Investor” by Burton Crane (hereinafter “Crane”). In the paragraph indicated in Crane, the term “dividends” is defined and a method of sharing corporate profits proportional with shares, is described. Proportional division of gain in a business is an old and well-known method of profit sharing in a business, but the method has not been used before the present application in combination with product design. An attempt to bring in the isolated teaching of Crane into the method disclosed in Bahar would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.⁴ While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record. In this case, the record fails to support the proposed modification of the method disclosed in Bahar. The position that the method disclosed in Bahar can be modified to arrive at the claimed method is insufficient to establish a *prima facie* case of obviousness.⁵ Moreover, neither Bahar nor Crane teaches or suggests “determining a final design of the product in which each element is as specified in the corresponding one adopted option.” Therefore, the Applicant respectfully submits that Bahar and Crane do not render obvious Claim 4, which depends on Claim 1.

NEW CLAIM 12

New Claim 12 recites “determining a design of the product in which each element is executed according to an embodiment selected by most participants.” Therefore, it is submitted that claim 12 patentably distinguishes over the prior art.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

⁴ See *In re Ehrreich* 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed “in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art,” and that one “must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.”)

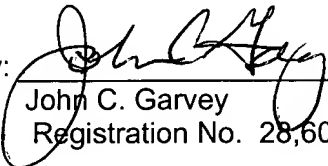
⁵See MPEP 2143.01 stating that the “fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness”; see also same section stating “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so,’” (citation omitted).

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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